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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,856	01/10/2002	Peter Selmeier	P01,0534	8833

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EXAMINER

SUMMONS, BARBARA

ART UNIT PAPER NUMBER

2817

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/030,856

Applicant(s)

SELMEIER, PETER

Examiner

Barbara Summons

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 6/30/03.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 8,9 and 13-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8,9,13 and 14 is/are allowed.
- 6) ☒ Claim(s) 15-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 30 June 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. The proposed corrected drawings were received on 6/30/03. These drawings are approved.

Although the drawings received 6/30/03 appear to be formal drawings, they cannot be used as substitute sheets because the changes were highlighted. Therefore, new clean formal sheets of drawings, reflecting the proposed corrections to Figs. 1 through 11B, are required (see item 11. on the form PTO-326). Since these formal drawings are obviously available, they should be submitted with the next reply to avoid possible errors in printing and speed the issue process.

### ***Specification***

2. The disclosure is objected to because of the following informalities:

Due to the Office conversion to the Image File Wrapper system, the Examiner will no longer be able to make minor corrections to the specification at the time of issue. Therefore, the following minor informalities must be corrected by Applicant:

On page 12 of the specification (i.e. the Substitute Specification received on 1/10/02), on each of line 2 of section [0075] and line 1 of section [0077], note that "couple parallel resonator" should be - - coupledl parallel resonator - - (see e.g. section [0071], line 2). Similarly, on pages 12 and 13, on each of line 1 of section [0082], line 2 of section [0083] and line 1 of section [0084], "couple pole point" should be - - coupledl pole point - - (see e.g. section [0070], line 1).

Appropriate correction is required.

***Claim Objections***

3. Claim 8 is objected to because of the following informalities:

In claim 8, on the next to last line thereof, "first resonator" should be - - first SAW resonator - -; and

in claim 8, on the next to last through last line thereof, "further first SAW" should be - - further first SAW resonator - - (see e.g. claim 8, lines 3 and 5, respectively).

Appropriate correction is required.

***New Grounds of Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 15-18 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 was previously written as a method of operating dependent upon an apparatus claim 8. The Examiner indicated that the method claims would be allowable if claim 15 were written in independent form to only the method and not the apparatus. However, when Applicant did this, all of the limitations of claim 8, some of which are necessary to understanding the method, were left out of claim 15. Therefore, claim 15 is not understandable on its own because: (1) there is no operable connection between the "first SAW resonator" and the "further first SAW resonator" (see lines 4-5); (2) there is no definition of "non-coupled first resonators" (see lines 6-7) because no "coupled"

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first resonators have been mentioned; and (3) there has been no mention of the how the "first" and "further first" SAW resonators relate to the "parallel resonators" mentioned in the last line of the claim. It should be noted that it is an essential element of the invention that the ground sides of the "first SAW resonator" and the "further first SAW resonator", which are parallel branch resonators, be coupled to each other.

Therefore, the missing operable connections and essential elements must be provided. It appears that this can be done by incorporating the subject matter of claim 8 (line 1 to at least line 13) into claim 15 either in the preamble of claim 15 or as method steps in the body of the claim 15 manufacturing method.

Correction/clarification is required.

***Allowable Subject Matter***

6. Claims 8, 9, 13 and 14 are allowed.
7. Claims 15-18 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. § 112, second paragraph, set forth in this Office action.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara Summons whose telephone number is (703) 308-4947. The examiner can normally be reached on M-Th, M-Fr.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bob Pascal can be reached on (703) 308-4909. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



**BARBARA SUMMONS**  
**PRIMARY EXAMINER**

bs  
September 21, 2003